

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Attorney Docket No.: 15037US02**

**PATENT**

In the Application of:	)	
	)	
Jeyhan Karaoguz, et al.	)	<b><u>Electronically Filed On July 8, 2009</u></b>
	)	
Serial No.: 10/675,436	)	
	)	
Filed: September 30, 2003	)	
	)	
For: MEDIA PROCESSING SYSTEM	)	
COMMUNICATING ACTIVITY	)	
INFORMATION TO SUPPORT USER	)	
AND USER BASE PROFILING AND	)	
CONSUMPTION FEEDBACK	)	
	)	
Examiner: Duffield, Jeremy S.	)	
	)	
Group Art Unit: 2427	)	
	)	
Confirmation No.: 5627	)	

**SECOND APPEAL BRIEF**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-37 of the present application. This Appeal Brief is timely because it is being filed within three months of the Office Action mailed June 15, 2009.

**REAL PARTY IN INTEREST**  
**(37 C.F.R. § 41.37(c)(1)(i))**

The real party in interest is Broadcom Corporation, having a place of business at 16215 Alton Parkway, Irvine, California 92619.

**RELATED APPEALS AND INTERFERENCES**  
**(37 C.F.R. § 41.37(c)(1)(ii))**

Not applicable.

**STATUS OF THE CLAIMS**  
**(37 C.F.R. § 41.37(c)(1)(iii))**

The present application includes claims 1-37. These claims stand rejected.<sup>1</sup> The Applicants identify claims 1-37 as the claims that are being appealed. The text of the claims involved in this Appeal, namely, claims 1-37, is provided in the Claims Appendix.

**STATUS OF AMENDMENTS**  
**(37 C.F.R. § 41.37(c)(1)(iv))**

Subsequent to the final rejection of claims 1-37 mailed November 25, 2008, the Applicants filed a Response.<sup>2</sup> The Response did not amend any of the claims.<sup>3</sup>

The Examiner then mailed an Advisory Action indicating that the Response did not place the application in condition for allowance.<sup>4</sup> Accordingly, the Applicants filed a Notice of Appeal and Appeal Brief.<sup>5</sup>

In response to the Appeal Brief, the current Office Action indicates that “Applicant’s arguments with respect to claims 1-37 have been considered but are moot in view of the new

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<sup>1</sup> See June 15, 2009 Office Action.

<sup>2</sup> See January 15, 2009 Response Under 37 C.F.R. § 1.116.

<sup>3</sup> See *id.*

<sup>4</sup> See January 27, 2009 Advisory Action.

ground(s) of rejection.”<sup>6</sup> The Office Action also notes the following:

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 ...; or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief can be applied to the new appeal.<sup>7</sup>

Therefore, the Applicants file a Notice of Appeal and this Second Appeal Brief.

### **SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))**

#### **Independent claim 1 recites the following:**

A method of communicating activity information to support user and user base profiling and consumption feedback in a communication network,<sup>8</sup> the method comprising:

establishing at a first location,<sup>9</sup> from a second location, at least one parameter<sup>10</sup> related to monitoring media consumption activity of a user at the first location;<sup>11</sup>

receiving, at the first location, a media request from the user,<sup>12</sup> the requested media<sup>13</sup> having an associated set<sup>14</sup> of pre-defined characteristics;<sup>15</sup>

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<sup>5</sup> See March 11, 2009 Notice of Appeal and Appeal Brief.

<sup>6</sup> See June 15, 2009 Office Action at page 2.

<sup>7</sup> See *id.*

<sup>8</sup> See present application, *e.g.*, at page 5, lines 2-4, page 14, lines 2-6, page 21, line 20 to page 22, line 13 and Figure 2.

<sup>9</sup> See *id.*, *e.g.*, at page 5, lines 17-19.

<sup>10</sup> See *id.*, *e.g.*, at page 6, lines 7-12.

<sup>11</sup> See *id.*, *e.g.*, at page 5, lines 4-7.

<sup>12</sup> See *id.*, *e.g.*, at page 5, lines 7-8.

<sup>13</sup> See *id.*, *e.g.*, at page 6, lines 3-6.

<sup>14</sup> See *id.*, *e.g.*, at page 6, lines 13-16.

determining, at the first location, whether the associated set of pre-defined characteristics matches the at least one parameter;<sup>16</sup>

sending notification of the media request to a second location, via a communication network,<sup>17</sup> if the determining results in a match;<sup>18</sup> and

refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.<sup>19</sup>

**Independent claim 9 recites the following:**

A method of communicating activity information to support user and user base profiling and consumption feedback in a communication network,<sup>20</sup> the method comprising:

establishing at a first location,<sup>21</sup> from a second location, at least one parameter<sup>22</sup> related to monitoring media consumption activity of a user at the first location;<sup>23</sup>

receiving, at the second location via the communication network,<sup>24</sup> notification of a media request by the user at the first location,<sup>25</sup> the requested media<sup>26</sup> having an associated set of pre-defined characteristics<sup>27</sup> matching the at least one parameter;<sup>28</sup>

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<sup>15</sup> See *id.*, e.g., at page 5, lines 8-9.

<sup>16</sup> See *id.*, e.g., at page 5, lines 9-11.

<sup>17</sup> See *id.*, e.g., at page 5, line 19 to page 6, line 3.

<sup>18</sup> See *id.*, e.g., at page 5, lines 11-14, and page 19, line 1 to page 21, line 19.

<sup>19</sup> See *id.*, e.g., at page 5, lines 14-16, and page 19, line 1 to page 21, line 19.

<sup>20</sup> See *id.*, e.g., at page 6, lines 17-19 and page 14, lines 2-6, page 14, lines 2-6, page 21, line 20 to page 22, line 13 and Figure 2.

<sup>21</sup> See *id.*, e.g., at page 7, lines 7-10.

<sup>22</sup> See *id.*, e.g., at page 7, line 18 to page 8, line 2.

<sup>23</sup> See *id.*, e.g., at page 6, lines 19-22.

<sup>24</sup> See *id.*, e.g., at page 7, lines 11-15.

<sup>25</sup> See *id.*, e.g., at page 7, lines 1-3.

<sup>26</sup> See *id.*, e.g., at page 7, lines 16-18.

<sup>27</sup> See *id.*, e.g., at page 8, lines 3-6.

<sup>28</sup> See *id.*, e.g., at page 7, lines 3-4, and page 19, line 1 to page 21, line 19.

creating at least one record of the media request, at the second location;<sup>29</sup> and  
sharing information derived from the at least one record with a third<sup>30</sup> party.<sup>31</sup>

**Independent claim 19 recites the following:**

A system supporting communication of activity information to support user and user base  
profiling and consumption feedback in a communication network,<sup>32</sup> the system comprising:

a television display<sup>33</sup> at a first location;

a storage for storing media,<sup>34</sup> at the first location, the storage having an associated<sup>35</sup>  
network address;<sup>36</sup>

a user interface accessible via the television display,<sup>37</sup> the user interface supporting the  
selection of media<sup>38</sup> for consumption;<sup>39</sup>

set top box circuitry,<sup>40</sup> at the first location, communicatively coupled to the storage to  
support consumption of the selected media;<sup>41</sup> and

server software<sup>42</sup> that receives, via a communication network,<sup>43</sup> data comprising the

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<sup>29</sup> See *id.*, e.g., at page 7, lines 4-6.

<sup>30</sup> See *id.*, e.g., at page 8, lines 6-8.

<sup>31</sup> See *id.*, e.g., at page 7, lines 6-7.

<sup>32</sup> See *id.*, e.g., at page 8, lines 9-12, page 14, line 2 to page 21, line 19 and Figures 1A, 1B and 1C.

<sup>33</sup> See *id.*, e.g., at page 8, lines 12-13, page 15, lines 10-13 and Figure 1A, refs 103 or 107.

<sup>34</sup> See *id.*, e.g., at page 8, lines 12-14 and page 24, lines 9-12.

<sup>35</sup> See *id.*, e.g., at page 9, lines 7-9 and page 15, lines 4-8.

<sup>36</sup> See *id.*, e.g., at page 8, line 14 and page 15, lines 4-8.

<sup>37</sup> See *id.*, e.g., at page 8, lines 14-16.

<sup>38</sup> See *id.*, e.g., at page 9, lines 4-7 and page 19, lines 14-18.

<sup>39</sup> See *id.*, e.g., at page 8, lines 16-17 and page 19, lines 21-22.

<sup>40</sup> See *id.*, e.g., at page 8, lines 17-18, page 15, lines 9-10, page 32, lines 10-13 and Figure 1A, refs. 102 or 106.

<sup>41</sup> See *id.*, e.g., at page 8, lines 17-19, page 31, lines 19 to page 32, line 5 and Figure 9, ref. 913.

<sup>42</sup> See *id.*, e.g., at page 8, lines 19-21 and page 33, line 8 to page 34, line 4.

<sup>43</sup> See *id.*, e.g., at page 9, lines 10-14 and Figure 3, ref. 304.

associated network address, a user identifier, and information related to the media selected for consumption,<sup>44</sup> and responds by storing at least a portion of the received data,<sup>45</sup> the server software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics<sup>46</sup> associated with the requested media matches at least one parameter<sup>47</sup> related to monitoring media consumption activity at the first location.<sup>48</sup>

**Independent claim 28 recites the following:**

A system supporting communication of activity information to support user and user base profiling and consumption feedback in a communication network,<sup>49</sup> the system comprising:

set top box circuitry,<sup>50</sup> at a first location, communicatively coupled to storage<sup>51</sup> having an associated network address,<sup>52</sup> at the first location, to support consumption of media selected via a user interface<sup>53</sup> accessible via a television<sup>54</sup> display;<sup>55</sup> and

software<sup>56</sup> that receives, via a communication network,<sup>57</sup> data comprising the associated network address, a user identifier, and information related to the media selected for

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<sup>44</sup> See *id.*, e.g., at page 8, line 21 to page 9, line 2.

<sup>45</sup> See *id.*, e.g., at page 9, lines 3-4.

<sup>46</sup> See *id.*, e.g., at page 6, lines 13-16.

<sup>47</sup> See *id.*, e.g., at page 9, lines 14-21.

<sup>48</sup> See *id.*, e.g., at page 5, lines 11-16, and page 19, line 1 to page 21, line 19.

<sup>49</sup> See *id.*, e.g., at page 8, lines 9-12, page 14, line 2 to page 21, line 19 and Figures 1A, 1B and 1C.

<sup>50</sup> See *id.*, e.g., at page 8, lines 17-18, page 15, lines 9-10, page 32, lines 10-13 and Figure 1A, refs. 102 or 106.

<sup>51</sup> See *id.*, e.g., at page 8, lines 12-14 and page 24, lines 9-12.

<sup>52</sup> See *id.*, e.g., at page 8, line 14 and page 15, lines 4-8.

<sup>53</sup> See *id.*, e.g., at page 8, lines 14-16.

<sup>54</sup> See *id.*, e.g., at page 8, lines 12-13, page 15, lines 10-13 and Figure 1A, refs. 103 or 107.

<sup>55</sup> See *id.*, e.g., at page 8, lines 16-17 and page 19, lines 21-22.

<sup>56</sup> See *id.*, e.g., at page 8, lines 19-21 and page 33, line 8 to page 34, line 4.

<sup>57</sup> See *id.*, e.g., at page 9, lines 10-14 and Figure 3, ref. 304.

consumption,<sup>58</sup> and responds by storing at least a portion of the received data,<sup>59</sup> the software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics<sup>60</sup> associated with the requested media matches at least one parameter<sup>61</sup> related to monitoring media consumption activity at the first location.<sup>62</sup>

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**  
**(37 C.F.R. § 41.37(c)(1)(vi))**

- Claims 1-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2002/0112239 (“Goldman”) in view of U.S. 5,600,364 (“Hendricks”).<sup>63</sup>

**ARGUMENT**  
**(37 C.F.R. § 41.37(c)(1)(vii))**

As noted, claims 1-37 stand rejected as being unpatentable over Goldman in view of Hendricks. In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some

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<sup>58</sup> See *id.*, e.g., at page 8, line 21 to page 9, line 2.

<sup>59</sup> See *id.*, e.g., at page 9, lines 3-4.

<sup>60</sup> See *id.*, e.g., at page 6, lines 13-16.

<sup>61</sup> See *id.*, e.g., at page 9, lines 14-21.

<sup>62</sup> See *id.*, e.g., at page 5, lines 11-16, and page 19, line 1 to page 21, line 19.

<sup>63</sup> Note, the previous Office Action rejected claims 1-37 as being anticipated by Goldman. The Examiner reopened prosecution after the Applicants filed the First Appeal Brief explaining that Goldman does not, in fact, anticipate any of the pending claims.

rational underpinning to support the legal conclusion of obviousness.”

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

The law and the MPEP are also clear that “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP at 2143.03 (emphasis added). Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” See *id.*

As explained below, Goldman fails to describe, teach or suggest at least “sending notification of the media request to a second location, via a communication network, if the determining results in a match;” and “refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.”

The Office Action acknowledges that “Goldman does not explicitly teach refraining from sending a notification of the media request to the second location, via the communication



network, if the determining does not result in a match.”<sup>64</sup> The Office Action seemingly relies on Hendricks at column 28, lines 3-15 as disclosing this limitation.<sup>65</sup> However, as explained below, Hendricks does not overcome the deficiencies of Goldman.

**I. The Proposed Combination Of Goldman And Hendricks Does Not Render Claims 1-8 Unpatentable**

Independent claim 1 recites, in part, the following:

determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location];

sending notification of the media request to a second location, via a communication network, if the determining results in a match; and

refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.

On the other hand, Goldman “relates to displaying information to viewers regarding the number of other viewers who are watching specified television programs.” *See* Goldman at [0003]. In particular, Goldman “relates to using a back channel to gather statistics relating to real time viewing behavior and using the gathered information to modify electronic program guides (EPGs) so as to inform viewers of the number of other viewers who are watching the television programs.” *See id.* In short, television viewing habits are assessed, and collective viewing stats are shown on EPGs. *See id.* at [0009] (“The present invention relates to systems and methods for utilizing a back channel as a feedback system to reveal what other television viewers are watching at a given moment”).

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<sup>64</sup> *See* June 15, 2009 Office Action at page 4.

<sup>65</sup> *See id.*

In Goldman, home entertainment systems track whether a broadcast is viewed or recorded.

Home entertainment system 90 tracks each time broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90, by generating viewer behavior information to indicate that the broadcast 88 was output, recorded or otherwise utilized at home entertainment system 90.

*Id.* at [0031]. EPGs are then updated and modified based on viewer behavior information. *See id.*, e.g., at [0044] (“once the viewing behavior information is received at the clearinghouse system 100, a processor 102 processes the information and/or makes the information available to modify the display of the EPGs of viewers in the system”).

**A. Contrary To The Assertion In the Office Action, Goldman Does Not Describe, Teach Or Suggest Determining, At The First Location, Whether The Associated Set Of Pre-Defined Characteristics Matches At Least One Parameter ...**

As detailed above, Goldman discloses a system in which viewer television habits are monitored, and those habits are compiled to update electronic program guides. The Applicants respectfully submit, however, that Goldman does not describe, teach or suggest “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the **requested media**] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1. Again, the Office Action acknowledges that Goldman does not describe, teach or suggest the “refraining.”

**There simply is nothing in Goldman that describes, teaches or suggests sending notification of a media request to a second location if an associated set of pre-defined characteristics associated with the requested media matches a parameter related to monitoring media consumption activity of a user at a first location. Further, there is nothing in Goldman that describes, teaches or suggests refraining from sending such a notification.** Moreover, the Office Action has not shown where any cited reference describes, teaches or suggest such limitations. Thus, for at least these reasons, the Applicants respectfully submit that the proposed combination of Goldman and Hendricks does not render claims 1-8 unpatentable.

Nevertheless, the Office Action specifically cites Goldman at paragraphs [0036]-[0037] as disclosing “determining, at the first location, whether the associated set of pre-defined characteristics matches the at least one parameter.” *See* June 15, 2009 Office Action at pages 3-4.

The Office Action also equates “viewer behavior information” with a “media request.” *See id.* at page 3. Further, the Office Action cites Goldman at reference 90 as the 1<sup>st</sup> location and reference 100 as the 2<sup>nd</sup> location. *See id.* at pages 3-4.

Based on these assertions, the Office Action reads claim 1, for example, as follows:

determining, at the first location **90**, whether the associated set of pre-defined characteristics [associated with the **viewer behavior information**] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location **90**];

sending notification of the **viewing behavior information** to a second location **100**, via a communication network, if the determining results in a match.

As explained below, however, there is nothing in Goldman that describes, teaches or suggests that a determination is made **at the home entertainment system 90** [which the Office Action views as the “first location”) as to whether a set of characteristics of the viewer behavior information [which the Office Action views as a “media request”) **matches** anything, let alone a parameter related to monitoring activity of a user **at the home entertainment system** [which the Office Action views as the second location].

Goldman discloses that the “[h]ome entertainment system 90 tracks each time broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90, by **generating viewer behavior information** to indicate that the broadcast 88 was output, recorded or otherwise utilized at home entertainment system 90.” *See* Goldman at [0031]. Thus, Goldman clearly states that the home entertainment system **generates the viewer behavior information**, which the Office Action seemingly construes as a “media request.” *See* June 15, 2009 Office Action at page 3 (“the requested media having an associated set of pre-defined characteristics, e.g., the tracking of viewer behavior information related to user at 1<sup>st</sup> location, 90...”).

However, **there is absolutely nothing in Goldman that describes, teaches or suggests that the home entertainment system** [which the Office Action concludes is the “first location”) **determines whether that viewer behavior information matches anything**. Instead, the home entertainment system merely generates the viewer behavior information. *See* Goldman at [0031].

Goldman does disclose, however, that “[o]nce an event occurs, home entertainment system 90 couples the occurrence of the event with information specific to the program output, recorded, or otherwise utilized.” *See id.* at [0036]. Again, however, Goldman merely states that it generates viewer behavior information, but not that the system 90 determines whether that

viewer information **matches** anything. Thus, for at least this reason, the Applicants respectfully request reconsideration of the claim rejections.

As shown above, independent claim 1 specifically recites “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match.” Thus, the claim is clear that if a determination is made **at the first location** that an associated set of **pre-defined characteristics associated with requested media match at least one parameter related to monitoring media consumption activity** of the user **at the first location**, then notification of **the media request** is sent to **a second location**. If there is no match, then no notification is sent.

As explained in detail above, Goldman merely discloses a system in which viewer television habits are monitored, and those habits are compiled to update electronic program guides. However, the Office Action cites Goldman at ¶¶ [0036]-[0037] and [0043] as somehow disclosing the limitations of claim 1 reproduced above. *See* June 15, 2009 Office Action at pages 3-4. In particular, the Office Action specifically relies on Goldman at ¶¶ [0036] and [0037] as disclosing “matching” predefined characteristics associated with requested media with at least one parameter related to monitoring media consumption activity of the user at the first location. *See id.* at page 4. Accordingly, the Applicants will now address these cited paragraphs.

Initially, Goldman at ¶ [0035] discloses the following:

Therefore, information **describing the viewing behavior (e.g., tuning, display, recording, scheduled recording, or setting a reminder) associated with particular television programs is tracked at home entertainment system 90.** The tracking may be initiated upon the occurrence of an event performed by a viewer of home entertainment system 90. In this description and in the claims, the term "event" encompasses an instructional input received by a home entertainment system, whereby video data corresponding to broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90. The input may be entered by the viewer or some other source. The term "event" also extends to other changes in programming displayed on the home entertainment system without viewer input, one example being the beginning of a scheduled program on an already-tuned channel.

*Id.* at ¶ [0035] (emphasis added). This portion of Goldman merely describes that information describing viewing behavior, such as tuning, display, recording, scheduling, etc., **is tracked** at a home entertainment system. **Notably, the viewing behavior at the home is tracked at the home entertainment system. That is, the viewing and tracking occur at the same location.** While this portion of Goldman discloses tracking viewing behavior at the same location as the viewing, it does not describe, teach or suggest “determining, **at the first location,** whether the associated set of pre-defined characteristics [associated with the requested media] **matches the at least one parameter** [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request to a second location,** via a communication network, if the determining results in a match,” as recited in claim 1. In general, this portion of Goldman, while disclosing tracking, does not describe, teach or suggest sending notification of a media request based on a determination of whether a match exists.

Next, Goldman at ¶ [0036] states the following:

Once an event occurs, home entertainment system 90 **couple**s the occurrence of the event with information specific to the program output, recorded, or otherwise utilized. This may include, for

example, **coupling** unique IDs from an EPG to an occurrence of an event. The IDs identify such information as the program viewed and the channel tuned. Thus, a processor 94 at home entertainment system 90 that is coupled with computer-executable instructions represents one example of means for generating viewer behavior.

*Id.* at ¶ [0036]. Thus, when an event, which is an “instructional input received by a home entertainment system, whereby video data corresponding to broadcast is output, recorded or otherwise utilized at the home entertainment system” (*see id.* at [0035]) occurs, the home entertainment system 90 **couples** the event with information specific to the program output, recorded or otherwise utilized. That is, **the home entertainment system merely connects the event with information regarding the program output.** Goldman does not describe, teach or suggest, however, that the home entertainment system **determines** if a **match** exists. Instead, it merely discloses that the event is coupled to information. In general, this **coupling** of Goldman is a “means for generating viewer behavior.” Further, the “instructional input,” such as video data being output, recorded or otherwise utilized, **is an action, but not a request.**

Neither this portion, nor the remainder, of Goldman, describes, teaches or suggests “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] **matches** the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match,” as recited in claim 1.

Next, Goldman at ¶ [0037] states the following:

Depending on the type and volume of viewer behavior information that is desired to be tracked, **specific data corresponding to the broadcast can be requested remotely.** In general, the type of viewer behavior is at least sufficiently detailed to enable the system

to determine the television program, if any, that is being displayed on the television. For example, the operator of central clearinghouse 80 to which the viewer behavior information is to be sent might decide that the desired types of information from the EPG that are to be included in the viewer behavior information are a channel ID, a subscriber ID, a program ID and title, the city and state of the channel, and the current date and time. Thus for each event, the foregoing information contained in the appropriate data fields of the EPG and information otherwise maintained at the home entertainment system is identified and stored as an instance of viewer behavior information.

*Id.* at ¶ [0037]. This portion of Goldman discloses that specific data corresponding to a broadcast can be requested, depending on the type and volume of viewer behavior. Information such as channel ID, subscriber ID, program ID, etc. may be stored. However, [0037] and the rest of **Goldman do not describe, teach or suggest that this “requested” data is in any way sent (or not sent) to another location based on a determination if a match exists between one set of information and another set of information.** That is, Goldman does not describe, teach or suggest “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match,” as recited in claim 1.

To summarize, the Office Action fails to show where Goldman describes, teaches or suggests:

- **determining at a first location** whether a set of pre-defined characteristics associated with requested media matches a parameter related to monitoring media consumption activity of the user at the first location,



- sending notification of a media **request** (not consumption, *per se*, of the media) to a **second location** if the determination **results in a match**, or
- refraining from sending notification of a media **request** (not consumption, *per se*, of the media) if the determination **does not result in a match**.

The Applicants reiterate that “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” *See* MPEP at 2143.03 (emphasis added). Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” *See id.* The Applicants respectfully submit that the Office Action has not shown that Goldman discloses various limitations that the Office Action concludes it does. Further, the Office Action does not assert that Hendricks remedies these demonstrated shortcomings. Thus, for at least these reasons, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of unpatentability with respect to claims 1-8. Indeed, the proposed combination of Goldman and Hendricks does not render these claims unpatentable.

**B. The Office Action Has Not Shown That Any Of The Cited References Describe, Teach Or Suggest “Refraining,” As Recited In Claim 1**

Claim 1 recites, in part, “refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.” The Office Action acknowledges that “Goldman does not explicitly teach refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.” *See* June 15, 2009 Office Action at page 4. In an attempt to overcome this deficiency, the Office Action cites Hendricks at column 28,

lines 3-15. *See id.* at pages 4-5. However, this cited portion of Hendricks states the following:

During transmission, the P/F bit 930, 930' is used to carry out the polling function. In particular, the P/F bit 930 is set to a "1" position to command a polling response from the set top terminal 220 whose address is identified in the frame 928. The set top terminal 220 addressed must respond to the command with the same P/F bit 930' also set to the "1" position. The response will include the number of programs accessed and their corresponding event identification numbers as shown in FIG. 10b at 933'. In cases where the set top terminals 220 has **not** accessed any program since the previous polling cycle, the set top terminal 220 **responds** with the P/F bit 930' set to "1" and the programs access block denoting zero programs accessed.

*See* Hendricks at column 28, lines 3-15 (emphasis added).

As shown above, the specific portion of Hendricks that the Office Action relies on as disclosing "refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match" merely indicates that the set top terminal actively responds with a P/F bit 930' set to "1" in the situation where the terminal has not accessed any program.

The cited portion of Hendricks makes no mention of a determination of whether a "match" exists with respect to a media request. Next, in stark contrast to "refraining from sending a notification," the cited portion of Hendricks clearly indicates that the terminal actually **responds**, as opposed to refraining from responding or sending a notification.

As noted above, the Office Action acknowledges that "Goldman does not explicitly teach refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match." *See* June 15, 2009 Office Action at page 4. Further, the cited portion of Hendricks that the Office Action specifically relies upon as showing this limitation simply does not describe, teach or suggest it.

Thus, for at least these additional reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to claims 1-8. Indeed, the proposed combination of Goldman and Hendricks does not render these claims unpatentable.

**II. The Proposed Combination Of Goldman And Hendricks Does Not Render Claims 9-18 Unpatentable**

Claim 9 recites, in part, “receiving, at the second location via the communication network, **notification of a media request** by the user, at the first location, the requested media having an associated set of pre-defined characteristics matching the at least one parameter.” For at least the reasons discussed above, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of unpatentability with respect to claims 9-18.

**III. The Proposed Combination Of Goldman And Hendricks Does Not Render Claims 19-27 Unpatentable**

Claim 19 recites, in part, “the server software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location.” For at least the reasons discussed above, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of unpatentability with respect to claims 19-27.

**IV. Claims 28-37**

Claim 28 recites, in part, “the software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location.” For at least the reasons discussed above, the

Applicants respectfully submit that the Office Action has not established a *prima facie* case of unpatentability with respect to claims 28-37.

**V. Conclusion**

For at least the reasons discussed above, the Applicants respectfully submit that the pending claims are allowable in all respects with respect to the cited art. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-37.

**PAYMENT OF FEES**

The Applicants note that the fees for the Notice of Appeal and the Appeal Brief have already been paid. *See* Notice of Appeal and Appeal Brief filed March 11, 2009. Nevertheless, the Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: July 8, 2009

/Joseph M. Butscher/  
Joseph M. Butscher  
Registration No. 48,326

McANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
(312) 775-8000

**CLAIMS APPENDIX**  
**(37 C.F.R. § 41.37(c)(1)(viii))**

1. A method of communicating activity information to support user and user base profiling and consumption feedback in a communication network, the method comprising:

establishing at a first location, from a second location, at least one parameter related to monitoring media consumption activity of a user at the first location;

receiving, at the first location, a media request from the user, the requested media having an associated set of pre-defined characteristics;

determining, at the first location, whether the associated set of pre-defined characteristics matches the at least one parameter;

sending notification of the media request to a second location, via a communication network, if the determining results in a match; and

refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.

2. The method of claim 1 wherein the first location is associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN).

3. The method of claim 1 wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure.

4. The method of claim 1 wherein the communication network is the Internet.

5. The method of claim 1 wherein the media comprises one or more of audio, a still image, video, real time video, and/or data.

6. The method of claim 1 wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data.

7. The method of claim 1 wherein the at least one parameter comprises a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, information indicating whether the user may be contacted, and information indicating how information related to the media request may be used.

8. The method of claim 1 wherein the associated set of pre-defined characteristics comprises one or more of a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, and/or a language.

9. A method of communicating activity information to support user and user base profiling and consumption feedback in a communication network, the method comprising:

establishing at a first location, from a second location, at least one parameter related to monitoring media consumption activity of a user at the first location;

receiving, at the second location via the communication network, notification of a media request by the user at the first location, the requested media having an associated set of pre-defined characteristics matching the at least one parameter;

creating at least one record of the media request, at the second location; and

sharing information derived from the at least one record with a third party.

10. The method of claim 9 wherein the first location is associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN).

11. The method of claim 9 wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure.

12. The method of claim 9 wherein the communication network is the Internet.

13. The method of claim 9 wherein the media comprises one or more of audio, a still image, video, real time video, and/or data.

14. The method of claim 9 wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data.

15. The method of claim 9 wherein the at least one parameter comprises a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, information indicating whether the user may be contacted, and information indicating how information related to the media request may be used.

16. The method of claim 9 wherein the associated set of pre-defined characteristics comprises one or more of a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, and/or a language.

17. The method of claim 9 wherein the third party is one or more of a third party media provider, a third party service provider, and a third party sales provider.

18. The method of claim 9 wherein the sharing uses the communication network.

19. A system supporting communication of activity information to support user and user base profiling and consumption feedback in a communication network, the system comprising:

a television display at a first location;

a storage for storing media, at the first location, the storage having an associated network address;

a user interface accessible via the television display, the user interface supporting the selection of media for consumption;

set top box circuitry, at the first location, communicatively coupled to the storage to support consumption of the selected media; and

server software that receives, via a communication network, data comprising the associated network address, a user identifier, and information related to the media selected for consumption, and responds by storing at least a portion of the received data, the server software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location.

20. The system of claim 19 wherein the media comprises one or more of audio, a still image, video, real time video, and/or data.

21. The system of claim 19 wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data.



22. The system of claim 19 wherein the associated network address is one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN).

23. The system of claim 19 wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure.

24. The system of claim 19 wherein the server software communicates, to the set top box circuitry, at least one parameter related to monitoring media consumption activity.

25. The system of claim 24 wherein the at least one parameter comprises a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, information indicating whether the user may be contacted, and information indicating how information related to the media request may be used.

26. The system of claim 19 wherein the server software shares, with a third party, information derived from the received data.

27. The system of claim 19 wherein the information related to media selected for consumption comprises one or more of a title, a subject, a time period, a genre, an artist, a media channel type, a. mode, a language, information identifying the user, and/or information indicating whether the user may be contacted.

28. A system supporting communication of activity information to support user and user base profiling and consumption feedback in a communication network, the system comprising:

set top box circuitry, at a first location, communicatively coupled to storage having an associated network address, at the first location, to support consumption of media selected via a user interface accessible via a television display; and

software that receives, via a communication network, data comprising the associated network address, a user identifier, and information related to the media selected for consumption, and responds by storing at least a portion of the received data, the software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location.

29. The system of claim 28 wherein the media comprises one or more of audio, a still image, video, real time video, and/or data.

30. The system of claim 28 wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data.

31. The system of claim 28 wherein the associated network address is one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN).

32. The system of claim 28 wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure.

33. The system of claim 28 wherein the software communicates, to the set top box circuitry, at least one parameter related to monitoring media consumption activity.

34. The system of claim 33 wherein the at least one parameter comprises a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, information indicating whether the user may be contacted, and information indicating how information related to the media request may be used.

35. The system of claim 28 wherein the software shares, with a third party, information derived from the received data.

36. The system of claim 28 wherein the information related to media selected for consumption comprises one or more of a title, a subject, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, and/or information indicating whether the user may be contacted.

37. The system of claim 28 wherein the software comprises server software.

**EVIDENCE APPENDIX**  
**(37 C.F.R. § 41.37(c)(1)(ix))**

- (1) U.S. 2002/0112239 (“Goldman”), entered into record by Examiner in November 8, 2007 Office Action.
- (2) U.S. 5,600364 (“Hendricks”), entered into record by Examiner in June 15, 2009 Office Action.

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Second Appeal Brief

**RELATED PROCEEDINGS APPENDIX**  
**(37 C.F.R. § 41.37(c)(1)(x))**

Not applicable.